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Filed : July 6, 2007

REMARKS

Claim 24 is canceled without prejudice to further prosecution. Claims 1, 8, and 16 have been amended. No new subject matter has been added. Applicant respectfully requests further consideration in light of the following remarks. Claims 1-23 are pending.

Discussion of Claim Objections

Claim 16 is objected to as being directed to a process. Claim 16 has been amended and is directed to a system. Accordingly, Applicant respectfully requests withdrawal of the objection.

Discussion of Claims Rejected Under 35 U.S.C. § 103(a)

In the Office Action, Claims 1-5, 7-12, 14-22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maloney (U.S. Patent Pub. No. 2008/0117053) in view of Grimes *et al.* (WO 2003/046819). Maloney discusses an object tracking system for tracking and controlling access to a plurality of objects, such as keys. See Maloney Abstract. Grimes discusses a computerized identity matching process. See Grimes Abstract.

Standard of Review

It is well established that the cited references must teach or suggest all the claim limitations. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Applicant respectfully submits that the claims are non-obvious over the combination of Maloney and Grimes because the claims recite limitations not found in the cited combination.

Claim 1

Applicant respectfully submits that the cited references do not individually or collectively disclose the combination of elements recited in Claim 1, as amended. For example, the cited references do not disclose a computerized identity matching management method for regulating the issue of secure assets, the method comprising "an issuer of an asset receiving a request for release of the asset from a receiver of the asset, identifying an asset having a unique classification

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identifier, after the request, identifying an issuer of the asset; and after the request, identifying a receiver of the asset.”

In paragraph 5 of the Office Action, Maloney is asserted as teaching “identifying an issuer of the asset,” and that the supervisor in Maloney corresponds to the issuer of the asset in the claim. Applicant respectfully submits that Maloney does not teach that the issuer of the asset is identified after the issuer of the asset receives a request for release of the asset from the receiver. Accordingly, at least for these reasons, Applicant respectfully submits that Claim 1 overcomes the cited art and is, therefore, in condition for allowance.

In addition, paragraph 5 indicates that the system of Maloney identifies an asset having a unique classification identifier. While the keys of Maloney may have an identifier, Applicant respectfully submits that there is no teaching in Maloney that each of the keys has a *classification* identifier, as required by Claim 1. Therefore, Applicant respectfully submits that the combination does not teach or suggest “identifying an asset having a unique classification identifier,” or “retrieving a privilege of the receiver to determine whether the privilege matches the classification identifier of the asset.”

Further, paragraph 5 indicates that abstract of Maloney teaches a computerized identity matching management process for regulating the issue of secure assets. However, the abstract of Maloney merely discloses “An enhanced object tracking system for tracking and controlling access to a plurality of objects such as keys is disclosed.” There is no teaching or disclosure that the assets are secure assets.

In paragraph 6, the Examiner acknowledges that Maloney is silent on utilizing a biometric capture process to capture a biometric of the issuer or the receiver as claimed in Claim 1. However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention to use the biometric capture process of Grimes in the asset issuing process of Maloney in order to automate user identification with a minimum of user identification. Applicant respectfully disagrees with the Examiner's conclusion. Applicant respectfully submits that Grimes does not make up for the deficiency of Maloney stated above. The combination of Maloney and Grimes therefore does not disclose each and every integer of the system of Claim 1.

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Accordingly, at least for these reasons, Applicant respectfully submits that Claim 1 overcomes the cited art and is, therefore, in condition for allowance.

Claims 8 and 15

In addition, Applicant respectfully submits that Claims 8 and 15 are also in condition for allowance at least because of reasons similar to those discussed above with regard to Claim 1.

Claim 3

In paragraph 9 of the Office Action, the Examiner, states that the combination of Maloney (referring to paragraph 54 and lines 11 to 14) and Grimes discloses the feature of Claim 3, namely generating an alert if the receiver's privilege does not match the asset classification. Applicant respectfully disagrees. In embodiments of Claim 3, the asset is not issued unless the user is determined to be authorized to be issued a particular asset. In contrast Maloney issues the asset (see the last sentence of paragraph 53), then at a later stage performs an inventory scan to determine whether "an authorized object is mistakenly removed or object removal is unauthorized". Only then is an alert generated. It is therefore submitted that claim 3 is patentable over the combination of Maloney and Grimes.

Claims 6, 13, and 23

In the Office Action, Claims 6, 13, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maloney in view of Grimes and Michael *et al.* (U.S. Patent Pub. No. 2003/0088442). Applicant respectfully submits that these dependent claims are in condition for allowance at least because of the features they include from the independent claims from which they depend and because of their own features. In addition, Applicant respectfully disagrees with the rejection.

Applicant respectfully submits that while Michaels teaches non-analogous art. Michaels is concerned with managing an inventory of items across a widely geographically distributed mobile work force.

Applicant respectfully submits that one of ordinary skill in the art of the issuance and return of secure assets would not turn to this non-analogous art in order to overcome the

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problems with Maloney and Grimes and to combine Maloney and Grimes with the different art of Michaels in order to arrive at the invention as presently claimed. The Examiner is respectfully referred to the following case which deals with issues of non-analogous art and also to MPEP paragraph 2141.01(a) for a discussion of analogous and non-analogous arts:

In re Pagliaro, 657 F.2d 1219 (CCPA 1981) ("Both the instant claims and Nutting involve decaffeination of vegetable materials; whereas, Aiello compares the solubility of a diuretic solution, such as a caffeine solution combined with an oil/serum mixture, to the same solution combined with an oil/water mixture... Thus, Aeillo's disclosure is not 'within the field of the inventor's endeavor.' Further, Aeillo is not pertinent to appellants' problem because he is not concerned with either beverage preparation or decaffeination of vegetable materials. There is no common environment which could form a 'close relationship' between either the claimed invention or Nutting on the one hand and Aeillo on the other to logically require consideration of Aeillo.").

Applicant respectfully submits that the field of managing an inventory across a geographically disperse area is not an analogous art with the field of the secure regulation of the issuance and return of assets to which the applicants' claims are directed.

Dependent Claims

Applicant does not necessarily agree with the characterization and assessments of the art with respect to the dependent claims, and respectfully submits that the dependent claims are in condition for allowance at least because of the features they include from the independent claims from which they depend and because of their own features.

Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

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Although the present communication may include alterations to the application or claims, or characterizations of claim scope or references, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
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Dated: 9/23/10

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